

## REMARKS

This Response is submitted in reply to the Non-Final Office Action dated November 25, 2008. Claims 1-5 are pending in this application. Claims 1-5 are rejected. In response, Claims 1 and 3-5 have been amended and Claim 2 has been cancelled. The amendment does not add new matter. In view of the amendment and/or for the reasons set forth below, Applicants respectfully submit the rejections are improper and should be withdrawn.

### Rejections under 35 U.S.C. 112

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Patent Office states the term “at least equal to a predetermined threshold” as recited in Claims 1 and 3-5 is a relative term which renders the claim indefinite. Office Action, page 2, lines 7-12. Applicants respectfully traverse this rejection for at least the reasons set forth below.

Claim 1 has been amended to recite, in part, “first determining means for determining whether the number of times counted by said counting means is at least equal to a predetermined ~~threshold~~maximum count; first instructing means which, if said number of times is found at least equal to said ~~threshold~~maximum count by said first determining means, then gives said transfer controlling means an instruction to stop the transfer of said data.” Claims 3-5 are similarly amended. The amendment is fully supported by the specification. For example, see paragraphs [0138]-[0139] of the published specification. Applicant respectfully submit that “maximum count” distinctly claims the subject matter and is not a relative term.

Claim 2 has been cancelled without prejudice or disclaimer.

Accordingly, Applicants respectfully request the 35 U.S.C. 112 rejection with respect to Claims 1-5 be reconsidered and the rejection withdrawn.

### Rejections under 35 U.S.C. 101

In the Office Action, Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In response, Applicants have amended Claim 4 to recite, in part, “A computer readable medium encoded with a program for causing a computer to carry out a procedure.”

Applicants submit that such language is statutory subject matter. For example, the MPEP §2106.01(I) states, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.2d at 1583-84, 32 USPQ2d at 1035.”

Accordingly, Applicants respectfully request that the 35 U.S.C 101 rejection with respect to Claim 4 be reconsidered and the rejection withdrawn.

### **Rejections under 35 U.S.C 103**

In the Office Action, Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over WO 2003/038571 to Ochi et al. in view of U.S. Patent No. 5,345,508 to Lynn et al. (“Lynn”). Please note that for purposes of this Response, U.S. Patent No. 7,275,161 to Ochi et al. (“Ochi”) is taken to be the English language equivalent to WO 2003/03857 and will be referred to herein, as done by the Patent Office. Applicants respectfully traverse the rejection for at least the reasons set forth below.

Claim 1 has been amended to recite, in part, “outputting means which, if the instruction to stop the transfer of said data is given by said first instructing means, then outputting to said external apparatus a message saying that the transfer of said data is stopped.” Claims 3-5 are similarly amended. The amendment is fully supported by the specification. For example, see paragraphs [0125] and [0140] of the published specification. Moreover, similar language was contained in cancelled Claim 2.

Regarding independent Claims 1 and 3-5, Applicants respectfully submit the cited prior art, even if properly combinable, fails to disclose, at a minimum, if the instruction to stop the transfer of data is given, outputting to said external apparatus a message saying that the transfer of said data is stopped. For example, the Patent Office relied on Ochi to teach this limitation as previously claimed in Claim 2. See Office Action, page 6, lines 9-15. However, Ochi discloses “[i]f the predetermined number has been reached, the medium authentication data transmission unit 12 notifies **the user** to this effect and ends the processing.” Ochi, column 13, lines 44-47 (emphasis added). Thus, Ochi merely discloses notifying a user and not outputting a message to “**said external apparatus**” as claimed, wherein said apparatus is the “external apparatus to and

from which is sent and received said data of which the transfer is controlled by said transfer controlling” means/step. The Patent Office relies on Ochi’s “Recording Medium Authentication Data Transmission Unit” and “Authentication Unit” to teach the claimed transfer controlling means; however, Ochi’s “Recording Medium Authentication Data Transmission Unit” and “Authentication Unit” send and receive data to and from Ochi’s “Information Recording Medium,” not the user. See Office Action, page Ochi, Fig. 1, items 12, 14, and 30. Moreover, Ochi merely teaches notifying a user that the predetermined number has been reached, and not that transfer of said data is stopped.

Further regarding Claim 1, Applicants respectfully submit that the Patent Office improperly relies on both Ochi’s “Data Processing Device” and “Information Recording Medium” to teach the claimed information processing apparatus. Specifically, within Ochi’s “Data Processing Device”, the Patent Office relies on the “Recording Medium Authentication Data Transmission Unit”/”Authentication Unit” to teach the claimed transfer controlling means, first determining means, and first instructing means. See Office Action, page 4, lines 1-17. And within Ochi’s “Information Recording Medium”, the Patent Office relies on the “Recording Medium Authentication Data Reception Unit” and “Encrypted Data Transmission Unit” to teach the claimed second determining means and second instructing means, respectively. See Office Action, page 4, line 17 – page 5, line 7. However, Applicants respectfully submit that one of ordinary skill in the art would not combine Ochi’s “Data Processing Device” and “Information Recording Medium” into a single information processing apparatus as claimed. Such a combination, even if operable, would render Ochi’s purpose of mutual authentication between the “Data Processing Device” and “Information Recording Medium” moot and would fail to disclose transferring data with an external apparatus.

Regarding Claim 2, Claim 2 has been cancelled without prejudice or disclaimer.

Applicants submit that Lynn fails to cure the deficiencies of Ochi. Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1-5 be reconsidered and the rejection withdrawn.

## **Conclusion**

For at least the foregoing reasons, Applicants respectfully submit the present application is in condition for allowance and earnestly solicit reconsideration of the same.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing. If such a withdrawal is made, please indicate the Attorney Docket No. 112857-914 on the account statement.

Respectfully submitted,

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